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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/652,376	08/31/2000	Arun Kumar Sinha	U 012930	4436
140	7590	05/17/2005	EXAMINER	
LADAS & PARRY 26 WEST 61ST STREET NEW YORK, NY 10023			KEYS, ROSALYND ANN	
			ART UNIT	PAPER NUMBER

1621

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/652,376

Applicant(s)

SINHA, ARUN KUMAR

Examiner

Rosalynd Keys

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2 and 4-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 4-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

Art Unit: 1621

**DETAILED ACTION**

***Status of Claims***

1. Claims 1, 2, and 4-7 are pending.  
Claims 1, 2 and 4-7 are rejected.  
Claims 3 and 8-12 are cancelled.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 2 and 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Devgan et al. (Aust. J. Chem., 1968, 21, 3001-3003) alone or in view of Patra et al. (Journal of Natural Products, Vol. 44, No. 6, November-December 1981, pages 668 and 669) and further in view of March (Advanced Organic Chemistry: Reactions, Mechanisms, and Structure, third edition, 1985, pp. 691-700 and 1093-1096), for the reasons given in the previous office action, mailed August 24, 2004.

***Response to Amendment***

***Claim Objections***

4. The objection to claim 4 is withdrawn, since the word calamus is now spelled correctly.

***Claim Rejections - 35 USC § 112***

5. The rejection of claims 1, 2 and 4-7 under 35 U.S.C. 112, second paragraph, is withdrawn, since the claims are now limited to preparing 1-propyl-2,4,5-trimethoxybenzene of the formula I from crude calamus oil from a tetraploid or hexaploid Acorus calamus.

***Response to Arguments***

6. Applicant's arguments filed February 28, 2005 have been fully considered but they are not persuasive.

The Applicant argues that there is no suggestion that  $\beta$ -asarone is present in *Caesulia Axillaries* therefore one skilled in the art would not look to Devgan for a process of preparing 1-propyl-2,4,5-trimethoxybenzene from an oil of a plant that contains a high percentage of  $\beta$ -asarone.

The Examiner disagrees. The Examiner believes that one having ordinary skill in the art at the time the invention was made would have found the process of Devgan useful for preparing 1-propyl-2,4,5-trimethoxybenzene, having the claimed formula I, from  $\beta$ -asarone, since Devgan et al. teach the identical process, except for its use of  $\gamma$ -asarone, which is an isomer of  $\beta$ -asarone. One having ordinary skill in the art would reasonably expect the two isomers to react similarly.

The Applicant argues that Devgan et al. do not provide the required motivation to reduce toxicity in crude calamus oil containing a high percentage of  $\beta$ -asarone. This argument is not persuasive since, the instant invention is directed to a method of preparing 1-propyl-2,4,5-trimethoxybenzene of the formula I by steps (a)-(d) and not to a method of reducing the in toxicity in crude calamus oil containing a high percentage of  $\beta$ -asarone.

The Applicant argues that Devgan and Patra are different from the instant process because they require an isolation step. This argument is not persuasive because the reaction is the same regardless of whether the asarone is reacted in pure form or in a mixture, i.e. in a crude calamus oil.

The Applicant argues that March does not teach or fairly suggest that the desired results could be obtained with a crude oil that contains compounds other than those that are being hydrogenated. This argument is not persuasive because March was not applied for this reason, it was applied to show that the hydrogenation conditions utilized by the Applicant are well known and thus prima facie obvious.

The Examiner believes that a prima facie case of obviousness has been shown. Thus, for the above reasons the rejection of claims 1, 2 and 4-7 under 35 U.S.C. 103(a) as being unpatentable over Devgan et al. alone or in view of Patra et al. and further in view of March is maintained.

**Conclusion**


7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosalyn Keys whose telephone number is 571-272-0639. The examiner can normally be reached on M and F 3:00-8:00 pm and T-TR 5:30-10:30 am.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Rosalyn Keys  
Primary Examiner  
Art Unit 1621

May 13, 2005